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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 523,619	03 13 2000	Yasuyuki Yoshimura	13041.3US01	6818

7277 7590 04 09 2002

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

21

DATE MAILED: 04 09 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523.619

Applicant(s)

YOSHIMURA ET AL

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED, 35 U.S.C. § 133.
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002 and 15 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

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DETAILED ACTION

1. All outstanding rejections except for those described below have been overcome by applicants' amendment filed 1/14/02 and supplemental amendment filed 3/15/02.

The new grounds of rejection as set forth below are necessitated by applicants' amendment.

Further, it is noted that page 5 of the amendment filed 1/14/02 states that applicants are filing a divisional application directed to the subject matter of pending claims 2, 4, 6, 8, 10, 12, and 14 and that upon filing of this divisional application, these claims would be withdrawn. The divisional application, 10/091,883 has in fact been filed and is pending. Until such time that applicants do in fact cancel present claims 2, 4, 6, 8, 10, 12, and 14, these claims are rejected by double patenting rejection as set forth in paragraphs 2-3 below as well as under 35 USC 103 as set forth in paragraphs 8-10 and 12 below. Of course, once these claims are cancelled in the present application, these rejections will be withdrawn.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 2, 4, 6, 8, 10, 12, and 14 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 22-28 of copending Application No. 10/091,883. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 2, 4, 6, 8, 10, 12, and 14 of the present application are identical to claims 22-28 of the copending application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 13, 21, 24, 30-31, 33, and 35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) In light of the amendment to claim 1 incorporating the median diameter of the glass flake, the scope of claim 7 is confusing since it also discloses the same median diameter of the glass flake. Applicant may wish to cancel claim 7 as redundant.

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(b) The scope of claims 13 and 21 are confusing since they both disclose identical limitation regarding the opacifying pigment. Applicant may wish to cancel either claim 13 or claim 21 to remove this redundancy.

(c) Newly added claims 24, 30, 33, and 35 each recite that the viscosity of the ink is measured using an ELD-type viscometer. The scope of the claim is confusing because it is not clear what is meant by "type". What viscometers are encompassed by the phrase "ELD-type"? The addition of the word "type" extends the scope of the claims so as to render them indefinite since it is unclear what "type" is intended to convey. The addition of the word "type" to the otherwise definite expression renders the definite expression indefinite by extending its scope. Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955).

Further, the scope of each claim is confusing because it is not clear what is meant by "3⁰ R14 corn". Should "corn" be changed to "cone"?

Further the scope of each of the claims is confusing because it is not clear why "3⁰ R14 cone: rotation speed:0.5 rpm: 20 °C" is in parentheses. Is the viscosity actually measured using this cone and at this temperature? If so, it is suggested that the parentheses are removed.

(d) Newly added claim 31 recites an improper Markush group. It is suggested that after "from" in line 2, the phrase "the group consisting of" is inserted.

Claim Rejections - 35 USC § 102

6. **NOTE:** Prior to setting forth the rejections under 35 USC 102 and 35 USC 103, it is noted that the rejections for JP 7118592 are based on the English translation previously provided by the examiner and attached to the office action mailed 7/12/01, Paper No.15.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2, 4, 6, 8, 10, 12, 14, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 10077438.

The rejection is adequately set forth in paragraph 3 of the office action mailed 7/12/01 and is incorporated here by reference.

9. Claims 2, 6, 8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 7118592.

The rejection is adequately set forth in paragraph 4 of the office action mailed 7/12/01 and is incorporated here by reference.

10. Claims 2, 4, 6, 8, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 600205.

The rejection is adequately set forth in paragraph 5 of the office action mailed 7/12/01 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over either JP 10077438, JP 7118592, or EP 600205 either of which in view of Okuda et al. (U.S. 5,510,397).

The rejection is adequately set forth in paragraph 7 of the office action mailed 7/12/01 and is incorporated here by reference.

13. Claims 1, 5, 7, 9, 22-24, and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7118592 in view of Yolles (U.S. 3,053,683).

JP 7118592 discloses a water-based metallic gloss ink for ball point pens comprising 5-20 wt% pearl pigment which has diameter of 5-60 μm , water-soluble resin including polysaccharide such as xanthan gum, 5-40% water-soluble solvent, dye, and water. The ink has a viscosity of 10,000-150,000 cPs (paragraphs 7-12). From example 1, it is calculated that the ink comprises, for example, 1% water-soluble resin. Further, it is disclosed that the ball point pen comprises hollow ink container wherein the above ink is stored and there is also disclosed a method of using the above ink in this ball point pen (paragraph bridging pages 10-11)

The difference between JP 7118592 and the present claimed invention is the requirement in the claims of (a) glass flake and (b) amount dye.

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Yolles disclose a metal coated glass flake suitable for use in coating compositions for substrates such as paper, i.e. ink, in order to produce a glittery finish (col.1, lines 10-13 and 24-28, col.2, line 15, col.3, lines 54-59, and col.8, line 14) wherein the metal coated glass flakes have average diameter of 140-325 mesh, i.e. 4-100 μm (col.6, lines 47-49).

In light of the motivation of using glass flakes disclosed by Yolles as described above, it therefore would have been obvious to one of ordinary skill in the art to use glass flakes in JP 7118592 in order to produce an ink with a glittery finish, and thereby arrive at the claimed invention.

With respect to argument (b), it is noted that paragraph 12 of JP 7118952 discloses the use of colorant such as dye, however, there is no disclosure of how much dye is utilized.

However, it would have been within the skill level of, as well as obvious to, one of ordinary skill in the art to choose amounts of dye, including that presently claimed, in order to adjust the hue, color, and optical density of the ink to the desired level, and thereby arrive at the claimed invention.

14. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7118592 in view of Yolles as applied to claims 1, 5, 7, 9, 22-24, and 28-35 above, and further in view of Allison et al. (U.S. 6,160,034).

The difference between JP 7118592 in view of Yolles and the present claimed invention is the requirement in the claims of resin emulsion binder.

Allison et al., which is drawn to ink for writing instrument, disclose the use of anionic resin emulsion which contains 30-60% solids and possesses minimum film-forming temperature

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of 15-25 °C in order to bind the colorant present in the ink to substrate (col.2, line 60-col.3, line 5, col.4, lines 7-12 and 50-52) . Given that the ink comprises 20-30% of the resin emulsion, it is clear that the resin emulsion contains about 6-18% of resin solids based on the entire ink composition.

In light of the motivation for using resin emulsion disclosed by Allison et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such resin emulsion in the ink of JP 7118592 in order to produce an ink which does not exhibit smearing or strike-through, and thereby arrive at the claimed invention.

15. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7118952 in view of Yolles as applied to claims 1, 5, 7, 9, 22-24, and 28-35 above, and further in view of Whyzmuzis (U.S. 5,714,526).

The difference between JP 7118952 in view of Yolles and the present claimed invention is the requirement in the claims of opacifying pigment.

Whyzmuzis, which is drawn to ink composition, discloses the use of opacifying pigment (col.7, lines 4-10) in order to produce an ink with good optical density.

In light of above, it therefore would have been obvious to one of ordinary skill in the art to use such pigment in the ink of JP 7118952 in order to produce an ink with good optical density, and thereby arrive at the claimed invention..

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16. Claims 1, 3, 5, 7, 9, 11, 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. (U.S. 6,039,796) in view of Yolles (U.S. 3,053,683).

The rejection is adequately set forth in paragraph 9 of the office action mailed 7 12 01 and is incorporated here by reference.

Kubota et al. is drawn to an ink jet ink, while the present claims have been amended to recite an "ball-point pen ink". However, applicants attention is drawn to MPEP 2111.02 which states that if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Further, statements in the preamble must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use as recited in the claim preamble of the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Kubota et al. disclose ink composition comprising pigment, water-soluble resin, solvent, and water, it is clear that the composition of Kubota et al. would be capable of performing the intended use, i.e. ball-point pen ink, presently claimed as required in the above cited portion of the MPEP.

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17. Claims 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. in view of Yolles as applied to claims 1, 3, 5, 7, 9, 11, 15-18, and 20 above, and further in view of Whyzmuzis (U.S. 5,714,526).

The rejection is adequately set forth in paragraph 10 of the office action mailed 7/12/01 and is incorporated here by reference.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. in view of Yolles as applied to claims 1, 3, 5, 7, 9, 11, 15-18, and 20 above, and further in view of Morita et al. (U.S. 6,099,629).

The rejection is adequately set forth in paragraph 11 of the office action mailed 7/12/01 and is incorporated here by reference.

Response to Arguments

19. Applicants' arguments regarding Babler (U.S. 5,554,217) and Sullivan (U.S. 5,753,371) have been fully considered but are moot in view of the discontinuation of these references against the present claims.

20. Applicants' arguments filed 1/14/02 and 3/15/02 have been fully considered but they are not persuasive.

Specifically, applicants argue:

(a) that there is no motivation to use JP 7118592 in combination with Yolles given that Yolles is not drawn to ink for ball-point pens and thus teaches nothing about the specific

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conditions that must be met by a ball-point pen ink as it is delivered onto a substrate to provide a written mark.

(b) Kubota et al. is drawn to ink jet ink not ball-point pen ink as presently claimed.

With respect to argument (a), applicants' are reminded that according to MPEP 2141.01 (a), a reference may be relied on as a basis for rejection of an applicants' invention if it is "reasonably pertinent to the particular problem with which the inventor is concerned." A reasonably pertinent reference is further described as one which "even though it maybe in a different field of endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." Yolles is, therefore, a reasonably pertinent reference, because it teaches that metal coated glass flakes are suitable for use in compositions which are used to coat paper and are useful as decorative pigments in other products "now employing pearl essence and metal flakes" (col.8, lines 12-25).

It is because of these teachings that the examiner believes Yolles to be an especially pertinent reference. That is, firstly, Yolles teaches that the metal coated glass flakes are suitable for use on composition which coats paper which is exactly what ink does as it leaves a ball-point pen: the ink coats the paper substrate to form a written mark. Secondly, Yolles' teaching that the metal coated glass flakes are useful as decorative pigments in other products "now employing pearl essence and metal flakes" is significant because the primary reference, JP 7118952, with which Yolles is combined, is an ink which uses pearl pigments. Thus, it is the examiner's position that there is good motivation to combine JP 7119852 with Yolles.

Applicants argue that Yolles' disclosure of coating composition is different from that of an ink composition. However, using the definition provided by applicant on page 11 of the amendment filed 1/14/02, i.e. that a coating is "a layer of protective or ornamental substance laid on in a single application", it is clear that the broad disclosure of coating by Yolles does encompass ink given that ink itself is an ornamental substance laid on paper in a single application.

Applicants argue on page 8 of the amendment filed 3/15/02, that the particle size of the glass flake is critical to a ball-point pen ink. However, it is noted that col.6, lines 47-49 of Yolles et al. disclose that the metal coated glass flakes have average diameter of 140-325 mesh, i.e. 4-100 μm , which is identical to the average diameter claimed.

Applicants also argue that the ink for ball-point pens must meet requirements imposed by the ball and the internal structure of the pen tip so that the ink is able to effectively move through, and discharge from, the pen in order to form a written mark. While it is agreed that there is no disclosure in Yolles regarding these requirements, it is noted that Yolles is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention. *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973). *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely the use of metal coated glass flakes suitable for producing a glittery finish, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

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Applicants also argue that the examples of Yolles show that the metal coated glass flakes are used in coating compositions which are non-aqueous which is in direct contrast to the present claims which are drawn to an aqueous ink. However, it is noted that applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Col.8, lines 21-25 of Yolles clearly indicate that the metal coated glass flakes are suitable for use as decorative pigment in any, i.e. aqueous or non-aqueous, product which now employs pearl pigments.

Applicants also argue that the primary object of the Yolles pigment, i.e. improved resistance to tarnishing, corroding, gassing and/or dulling" has no bearing on ball-point pen ink as disclosed by JP 7118952 or the present invention. However, "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by prior art does not agree with appellant's motivation", *In re Dillon*, 160 USPQ 2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1966). Further, it is the examiner's position that it would be important that an ink composition not dull over time but retain is glittering appearance.

Thus, it is the examiner's position that JP 7118952 and Yolles remain relevant reference against the present claims.

With respect to argument (b), applicants attention is drawn to MPEP 2111.02 which states that if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

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Further, statements in the preamble must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use as recited in the claim preamble of the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Kubota et al. disclose ink composition comprising pigment, water-soluble resin, solvent, and water, it is clear that the composition of Kubota et al. would be capable of performing the intended use, i.e. ball-point pen ink, presently claimed as required in the above cited portion of the MPEP.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

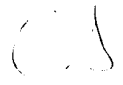
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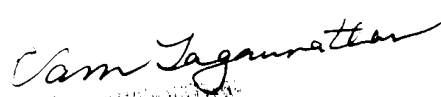
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Callie Shosho
April 4, 2002


VASU JAGANNATHAN
SUPERVISOR
TECHNICAL CENTER